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09/748,957	12/27/2000	Wilson J. Chan	37730-10001	5915

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Jenner & Block
Patent and trademark Docket Clerk
One IBM plaza. 41st Floor
Chicago, IL 60611

EXAMINER

EDELMAN, BRADLEY E

ART UNIT

PAPER NUMBER

2153

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/748,957

Applicant(s)

CHAN, WILSON J.

Examiner

Bradley Edelman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 10-15 and 18-23 is/are rejected.
- 7) ☒ Claim(s) 7-9, 16 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: _____

DETAILED ACTION

This office action is the first action on the merits of this case. Claims 1-23 are presented for examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States,

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 1, 2, 5, 10-14, and 18-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Clynes (U.S. Patent No. 5,590,282).

In considering claim 1, Clynes discloses a system comprising:

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A memory for storing a media file (central storage); a host computer (central computer station 10); and a personal communication device (subscriber post), said personal communication device having access to said memory and said personal communication device being adapted to transmit the media file to said host computer (col. 5, lines 10-20; col. 6, lines 40-41, wherein the user creates the microscore and sends it to the central station to be stored);

Means accessible to said host computer for modifying the media file (col. 5, lines 62-67); and

Means for storing the modified media file (col. 6, lines 1-5).

Claims 13, 14, 18, and 23 contain similar limitations to claim 1 and are thus rejected for the same reasons regarding claim 1. See also col. 7, lines 24-29, describing transformation and a second memory store on the host (i.e. storing the file as a sound file on a digital tape at the central location).

In considering claim 2, Clynes further discloses that the host computer is adapted to transmit information to the personal communication device (col. 6, lines 30-31).

In considering claims 5 and 22, Clynes further discloses that the host computer is adapted to receive a media file that is any of a plurality of predetermined formats (i.e. video, audio, music notation, as described below).

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In considering claims 10 and 20, Clynes further discloses that the host computer is adapted to receive a video file (col. 6, lines 46-48, "video program").

In considering claims 11 and 19, Clynes further discloses that the host computer is adapted to receive an audio file (col. 7, lines 24-25, "sound file").

In considering claims 12 and 21, Clynes further discloses that the host computer is adapted to receive a music notation file (col. 4, lines 61-67, "microscore").

2. Claims 1-3, 5, 12-14, 18, 19, 21, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Sung et al. (U.S. Patent No. 6,423,893).

In considering claim 1, Sung discloses a system comprising:

A memory for storing a media file (database 16); a host computer (server 15); and a personal communication device (client computer 10), said personal communication device having access to said memory and said personal communication device being adapted to transmit the media file to said host computer (col. 3, lines 60-63; col. 4, lines 31-35, wherein a user at a client creates a file and stores it at the server);

Means accessible to said host computer for modifying the media file (col. 3, line 34, "update" the information); and

Means for storing the modified media file (col. 3, lines 62-63).

Claim 13 contains similar limitations to claim 1 and is thus rejected for the same reasons regarding claim 1.

Claim 14 also contains similar limitations to claim 1, except that it includes "transforming" a media file, rather than simply "modifying" the file. Nonetheless, Sung further teaches means for the host computer to transform media files (col. 6, lines 3-10, converting from meta-data format into digital audio or MIDI data format).

In considering claim 18, Sung discloses a method for modifying a media file, comprising the steps of:

Providing a media file in a first memory accessible by a personal communication device; transmitting the media file over a network to a host computer; (col. 3, lines 60-63; col. 4, lines 31-35, wherein a user creates a file at the client machine, which necessarily stores the created file at a first browser memory until the file is sent to the server);

Modifying the media file on hardware and software connected to the host computer (col. 4, line 34, "update" the file); and

Storing the modified data file in a second memory associated with the host computer (col. 5, lines 4-11, wherein the modified file is stored in database 16).

In considering claim 2, Sung further discloses that the host computer is adapted to transmit information to the personal communication device (col. 5, line 10).

In considering claim 3, Sung further discloses that the host computer is adapted to receive the media file from said personal communication device over the Internet (col. 3, line 60).

In considering claims 5 and 22, Sung further discloses that the host computer is adapted to receive a media file that is any of a plurality of predetermined formats (col. 4, lines 35-40).

In considering claims 12 and 21, Sung further discloses that the host computer is adapted to receive a music notation file from a first memory accessible by a personal communication device (col. 4, lines 35-40).

In considering claim 19, Sung further discloses providing an audio file in a first memory accessible by a personal communication device (col. 6, lines 3-9, wherein the digital audio file is sent to the client device as an HTTP response, wherein it is inherently stored, at least temporarily).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3, 4, 6, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clynes, in view of what was well known in the art at the time the invention was made.

In considering claims 3 and 4, although the system taught by Clynes discloses the use of a TV network to connect the client and server computers, it fails to disclose the use of an Internet or a private network. Nonetheless, Examiner takes official notice that the use of the Internet and/or a private network for accessing remote data is well known in the networking art. Thus, given such knowledge, a person having ordinary skill in the art would have readily recognized the desirability and advantages of implementing the network system taught by Clynes either on an Internet to extend accessibility to all users worldwide, or on a private network to restrict accessibility to only a select few. Therefore, it would have been obvious to implement the system taught by Clynes over an Internet or private network.

In considering claims, 6 and 15, Clynes further fails to disclose that the modifying means includes a patchbay and media interface device. Nonetheless, the use of patchbay and media interface devices to allow modification to a media file is well known, as admitted by Applicant in Applicant's application (see p. 6, lines 14-21, describing the use of the Midiman Digipatch 12 x 6 patchbay available from Midiman to make modifications to media files, "as is known to those of ordinary skill in the art"). Therefore, it would have been obvious to a person having ordinary skill in the art to use

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conventional means to convert the files, to avoid the time and effort required to build an entirely new program that performs the same function.

4. Claims 4, 6, 15, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sung.

In considering claim 4, although the system taught by Sung discloses the use of the Internet to connect the client and server computers, it fails to disclose the use of a private network. Nonetheless, Examiner takes official notice that the use of a private network for accessing remote data is well known in the networking art. Thus, given such knowledge, a person having ordinary skill in the art would have readily recognized the desirability and advantages of implementing the network system taught by Sung on a private network, to restrict accessibility to only a select few. Therefore, it would have been obvious to implement the system taught by Sung over a private network.

In considering claims, 6 and 15, Sung further fails to disclose that the modifying means includes a patchbay and media interface device. Nonetheless, the use of patchbay and media interface devices to allow modification to a media file is well known, as admitted by Applicant in Applicant's application (see p. 6, lines 14-21, describing the use of the Midiman Digipatch 12 x 6 patchbay available from Midiman to make modifications to media files, "as is known to those of ordinary skill in the art"). Therefore, it would have been obvious to a person having ordinary skill in the art to use

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conventional means to convert the files, to avoid the time and effort required to build an entirely new program that performs the same function.

In considering claim 23, Sung discloses a method for transforming a media file, comprising the steps of:

Providing a media file in a first memory accessible by a personal communication device, and transmitting the media file over a network to a host computer; (col. 3, lines 60-63; col. 4, lines 31-35, wherein a user creates a file at the client machine, which necessarily stores the created file at a first browser memory until the file is sent to the server); and

Transforming the media file on hardware and software connected to the host computer (col. 6, lines 3-9, "converting" the file to digital audio format).

However, Sung does not explicitly disclose storing the modified data file in a second memory associated with the host computer. Instead, Sung teaches that the transformed files are created dynamically and are sent to the client (see col. 4, lines 4-14). Nonetheless, Sung does teach storing some of the client-accessible files on the server (i.e. the musical arrangement/passage files). Thus, it is well known that files can be stored on a server. A person having ordinary skill in the art would have readily recognized the desirability and advantages of therefore storing certain *transformed* files on the server taught by Sung, so that musical files that never change do not waste system resources by requiring dynamic transformation every time they are requested.

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Therefore, it would have been obvious to store the transformed files on a second memory store associated with the host computer.

Allowable Subject Matter

5. Claims 7-9 and 16-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In considering these claims, the prior art of record fails to disclose or render obvious the claimed system and method, wherein a media switch matrix is employed to route the media file to the modifying means, and wherein a media interface device control repeater is used for selecting one of a predetermined plurality of modifications to be performed by the modifying means.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is (703) 306-3041. The examiner can normally be reached on Monday to Friday from 8:30 AM to 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on (703) 305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

For all After Final papers: (703) 746-7238.

For all other correspondences: (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

BE
April 28, 2003



GLENTON B. BURGESS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100